

REMARKS

In the Office Action dated September 12, 2003, claims 12-14 stand rejected under 35 U.S.C. §112, first and second paragraphs. Claims 12-14 also have been rejected as obvious under 35 U.S.C. §103(a) over U.S. Patent No. 3,653,959 to Kehr et al. (hereinafter "Kehr") or U.S. Patent No. 5,344,635 to Bujard et al. (hereinafter "Bujard").

As an initial matter, Applicants respectfully point out that claim 14 was cancelled in a Preliminary Amendment dated November 8, 2001. Accordingly, claim 14 is not pending in the present application.

Applicants have herewith amended claims 12 and 13. These amendments when considered with the remarks set forth below are deemed to place the application in condition for allowance. Claims 12 and 13 remain pending for continued examination. Reconsideration of the application is respectfully requested.

Rejection of Claims 12 and 13 under U.S.C. §112, First Paragraph

Claims 12 and 13 stand rejected for lack of enablement because the specification, "while being enabling for the disclosed polyoxypolyolefin, does not reasonably provide enablement for the entire scope of the polyoxypolyolefin type." See Office Action at page 2.

In response, Applicants have amended claims 12 and 13 to recite that the elastomer has the general formula set forth in the specification. Support for this amendment is found in the specification at page 3, line 17 through page 4, line 4, which provides the formula for the repeating unit of the elastomer. Thus, no new matter is being added by this amendment. Withdrawal of the rejection is respectfully requested.

Rejection of Claims 12 and 13 under U.S.C. §112, Second Paragraph

Claims 12 and 13 have been rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention. See Office Action at page 2. In view of the amendment of claims 12 and 13 noted previously, Applicants submit that claims 12 and 13 are not vague and indefinite. Withdrawal of the rejection of claims 12 and 13 is respectfully requested.

Rejection of Claims 12 and 13 under 35 U.S.C. §103(a)

Claims 12 and 13 stand rejected as obvious in light of either Kehr or Bujard. It is the Examiner's contention that the elastomeric polymers and heat conducting fillers taught by either the Kehr or Bujard patent render the claimed invention obvious to one skilled in the art. See Office Action at pages 3-4.

In response, Applicants respectfully submit that a prima facie case of obviousness has not been set forth. As set forth in Section 2142 of the Manual of Patent Examining Procedure (M.P.E.P.), a prima facie case of obviousness requires three basic criteria to be met:

First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined), must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not on the applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1981) (emphasis added).

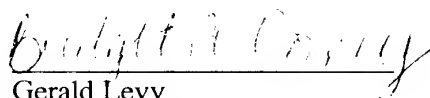
First, the above-cited references fail to teach or suggest all the limitations of claims 12 and 13, as amended. Neither of the cited references discloses the general formula for the elastomer now set forth in claims 12 and 13. This formula is a requisite element of claims 12

and 13. Second, the Office Action fails to recite how either patent provides one skilled in the art of reasonable expectation of success in achieving Applicants' claimed invention. Neither the Kehr nor Bujard patent provides an indication as to how to use a conductive paste based on an elastomer with the general formula now recited in claims 12 and 13. Accordingly, the cited prior art fails to provide one skilled in the art with a reasonable expectation of success. Therefore, it is respectfully submitted that the Examiner has failed to demonstrate a prima facie case of obviousness. In light of the above, withdrawal of the rejection of claims 12 and 13 is respectfully requested.

Applicants respectfully submit that the application is in condition for allowance which action is earnestly solicited. If for any reason the application is not deemed in condition for allowance, the Examiner is respectfully requested to contact the undersigned attorney so that additional amendments may be entered as necessary.

Applicants do not believe that any fees are due with this response. However, if any fees are due, please charge such sums to our Deposit Account 50-1145.

Respectfully submitted,

  
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